

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK CAMAIONI

Appeal No. 2006-3346
Application No. 10/660,988
Technology Center 3600

Decided: March 30, 2007

Before TERRY J. OWENS, STUART S. LEVY, and ANTON W. FETTING,
Administrative Patent Judges.

LEVY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 2-12 and 14-21. Claim 1 has been cancelled. Claim 13 has been withdrawn from consideration (Br. 2). We have jurisdiction over this appeal under 35 U.S.C. § 6(b) (2002).

Appeal 2006-3346
Application 10/660,988

We REVERSE.

STATEMENT OF THE CASE

Appellant's invention relates to an add-on extension section for a conventional ladder (Specification 2).

Claim 11 is representative of the invention, and is reproduced as follows:

11. A ladder extension section adapted to be removably mounted to a conventional ladder, said ladder extension section comprising a pair of opposed sidewalls, a plurality of transversely oriented rungs extending between said pair of opposed sidewalls, and means on said ladder extension section for engaging at least one rung of a conventional ladder for removably mounting said ladder extension section to a conventional ladder, the distance between the pair of opposed sidewalls of said ladder extension section being greater than the distance between the opposed sidewalls of a conventional ladder such that the sidewalls of said ladder extension section extend beyond the sidewalls of a conventional ladder when said ladder extension section is mounted to a conventional ladder.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Edmunds	US 0,124,940	Mar. 26, 1872
Parent	US 0,146,274	Jan. 6, 1874
Bauer	US 1,600,572	Sep. 21, 1926
Brugner	US 1,672,020	Jun. 5, 1928
Jenkins	US 2,471,110	May 24, 1949
Stanley	US 2,720,354	Oct. 11, 1955
Lee	UK 2 118 236 A	Oct. 26, 1983
Hulme	US 4,519,478	May 28, 1985

Claims 11, 12, and 14-20 stand rejected under 35 U.S.C. § 112 (second paragraph) as being indefinite.

Appeal 2006-3346
Application 10/660,988

Claims 11, 12, 14-16, and 18-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brugner.

Claims 2-8, 11, 12, and 14-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lee.

Claims 2-5, 12, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hulme.

Claims 2-7, 12, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jenkins in view of Lee.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brugner in view of Bauer.

Claims 8-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edmonds in view of Stanley.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edmonds in view of Parent.

Claims 6 and 7 stand rejected over 35 U.S.C. § 103(a) as being unpatentable over Edmonds in view of Lee.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellant regarding the above-noted rejections, we make reference to the Examiner's Answer (Hereinafter: Answer, mailed August 7, 2006) for the Examiner's complete reasoning in support of the rejections, and to the Corrected Appeal Brief (Hereinafter: Br., filed February 28, 2006) and Reply Brief (Hereinafter: Reply Br., filed June 26, 2006) for the Appellant's arguments thereagainst.

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered. *See* 37 C.F.R. § 41.37(c)(1)(vii)(eff. Sep. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, and the evidence of indefiniteness, anticipation, and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer. Upon consideration of the record before us, we make the determinations which follow.

We begin with the rejection of claims 11, 12, and 14-20 under 35 U.S.C. § 112 (second paragraph). The Examiner contends (Answer 4) that because the preamble only calls for the extension, the limitations regarding the conventional ladder render the claims indefinite. Appellant asserts (Br. 7) that reference to a conventional ladder defines the operating environment of the extension ladder and the functional relationship between the extension ladder and the conventional ladder to which the extension is mounted.

From our review of the record, we find that the conventional ladder as recited in these claims is not part of the claimed combination, but rather that the

ladder extension is made for use with a conventional ladder. Accordingly, we agree with Appellant that the reference to the conventional ladder defines the operating environment of the extension ladder. As such, we hold that an artisan would understand the metes and bounds of the claims. The rejection of claims 11, 12, and 14-20 under 35 U.S.C. § 112 (second paragraph) is not sustained.

We turn next to the rejection of claims 11, 12, 14-16, and 18-20 under 35 U.S.C. § 102(b) as being anticipated by Brugner. To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. *See Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

The Examiner contends (Answer 4) that the extension of Brugner is capable of being used with conventional ladders having a width less than or abutting Brugner's extension rails. Appellant asserts (Br. 10) that the express disclosure of Brugner is exactly opposite to that disclosed by Appellant because ladder section 29 is slightly narrower than the ladder section 2. From our review of Brugner, we find that "29 indicates an additional ladder section which may be detachably secured to the ladder section 2 when the device is converted into an extension ladder for the purpose of making a longer ladder. The ladder section 29 is slightly narrower than the ladder section 2." (Brugner, p. 2, ll. 79-85). From this description of Brugner, we find that the reference makes the extension 29 narrower, not wider, than ladder 2. The purpose of this, as described by Brugner, is for the sides of the extension 29 to rest between the sides 11 of ladder section 2.

Thus, we do not find that it would have been inherent to use the extension of Brugner with a ladder that has narrower sides than the extension. Inherency cannot be established by possibilities or probabilities, but must necessarily flow from the teachings of the prior art. It follows that we cannot sustain the rejection of claims 11, 12, 14-16, and 18-20 under 35 U.S.C. § 102(b).

We turn next to the rejection of claims 2-8, 11, 12, and 14-21 under 35 U.S.C. § 102(b) as being anticipated by Lee. The Examiner contends (Answer 5) that extension 10 of Lee is capable of being used with conventional ladders having a width abutting Lee's extension sidewalls. Appellant asserts (Br. 11) that Lee describes an attachment for stabilizing a ladder to prevent lateral sway, and does not suggest an extension for a ladder. From our review of Lee, we find that the reference is directed to a ladder attachment (Lee, p. 1, l. 5). We find no description of a ladder extension, and the Examiner has not pointed to any teaching of Lee that can be considered a ladder extension. We are cognizant that bars 14, 15 extend between limbs 13 (Lee, p. 1, ll. 112-118). However, these bars do not constitute steps of a ladder and are therefore not rungs¹ of a ladder. Each of independent claims 11, 18, and 21 recite rungs that extend between the opposed sidewalls of the ladder extension. It follows that we cannot sustain the rejection of claims 2-8, 11, 12, and 14-21 under 35 U.S.C. § 102(b) as being anticipated by Lee.

We turn next to the rejection of claims 2-5, 12, and 21 under 35 U.S.C. § 102(b) as being unpatentable over Hulme. The Examiner contends (Answer 5) that Hulme in figure 7 shows a ladder extension 120 with engaging means 160 and a

¹ *Webster's New World Dictionary* © 1972.

Appeal 2006-3346
Application 10/660,988

ladder 110. Appellant contends that in Hulme, the narrower base section includes means for engaging the rungs of the wider section, which is exactly the opposite of the express recitation of independent claim 21 that means are provided on the extension for engaging a rung on a conventional ladder.

From our review of Hulme, we find that in figures 7 and 8, the width of the extension 110 is narrower than the width of ladder L. In figure 9, the extension 112 is wider than the ladder 122. In this embodiment, the means for connecting the ladder extension to the ladder are located on the ladder, not on the extension as claimed. Accordingly, we find no embodiment in Hulme where the extension is wider than the ladder and the means for connecting the extension to the ladder are on the extension. It follows that we cannot sustain the rejection of claims 2-5, 12, and 21 under 35 U.S.C. § 102(b) as being anticipated by Hulme.

We turn next to the rejection of claims 2-5, 12, and 21 under 35 U.S.C. § 102(b) as being anticipated by Edmonds. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v.*

Appeal 2006-3346
Application 10/660,988

Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. *See id.*; *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The Examiner contends (Answer 5) that Edmonds shows engaging means at C, E, and F. Appellant contends (Br. 12) that Edmonds discloses a device for splicing two ladders together and does not disclose a conventional ladder in combination with a ladder extension. From our review of Edmonds, we find that although extension B is wider than ladder A, the splicing mechanism C, E, F is not on the ladder extension as claimed, but is located between the ladders. It follows that we agree with Appellant that Edmonds fails to anticipate independent claim 21. The rejection of claims 2-5, 12, and 21 under 35 U.S.C. § 102(b) is not sustained.

We turn next to the rejection of claims 2-7, 12, and 21 under 35 U.S.C.

§ 103(a) as being unpatentable over Jenkins in view of Lee. The Examiner contends (Answer 5) that Jenkins does not show the first and second pairs of engaging elements. To make up for this deficiency of Jenkins, the Examiner turns to Lee for a suggestion of first and second pairs of engaging elements 24 and 25. Appellant contends (Br. 13-14) that in Jenkins, the top section of the ladder does not engage the rungs of the ladder section, but rather that openings are drilled in the top and bottom sections to retain the two sections together. With respect to Lee, Appellant refers to the earlier presented remarks.

At the outset, we note that the limitation listed by the Examiner as not being found in Jenkins, namely the first and second pairs of engaging elements, is not found in independent claim 21. Rather this limitation only appears in dependent claim 6. In addition, it is unclear as to why claim 12 was included in this group as claim 12 depends from claim 11, not claim 21. In any event, from our review of Jenkins, we agree with Appellant that openings are provided in the inner and outer ladder sections. We add that the openings receive pins 19, which keep the ladders together. (Jenkins, col. 1, l. 47-col. 2, l. 6). Although we find from the description of Lee that two pairs of hooks 24, 25 are used to connect the attachment to the ladder (Lee, p. 2, ll. 10-25), we find that an artisan would not have been motivated to replace the pins and holes of Jenkins with the plural sets of hooks of Lee because Lee is not directed to a ladder extension. Thus, we find that the combined teachings and suggestions of Jenkins and Lee would not have suggested the language of claims 2-7, 12, and 21. Accordingly, we will not sustain the rejection of claims 2-7, 12, and 21.

We turn next to the rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Brugner in view of Bauer. The Examiner contends (Answer 6) that Brugner does not show the claimed extension of the support element. To overcome the deficiency of Brugner, the Examiner turns to Bauer for a suggestion of providing a support element, shown at 70. We will not sustain the rejection of claim 17 because Bauer does not make up for the basic deficiencies of Brugner, as discussed, *supra*.

We turn next to the rejection of claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Edmonds in view of Stanley. The Examiner contends that Stanley suggests the claimed support element. We will not sustain the rejection of claims 8-10 because Stanley does not make up for the deficiencies of Edmonds, as discussed, *supra*.

We turn next to the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Edmonds in view of Parent. The Examiner contends (Answer 7) that Parent suggests the claimed first and second engaging elements C, E. We will not sustain the rejection of claims 6 and 7 because Stanley fails to make up for the deficiencies of Edmonds, as discussed, *supra*.

We turn next to the rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Edmonds in view of Lee. We will not sustain the rejection of claims 6 and 7 because Lee fails to make up for the deficiencies of Edmonds.

Appeal 2006-3346
Application 10/660,988

ORDER

The decision of the Examiner to reject claims 11, 12, and 14-20 under 35 U.S.C. § 112 (second paragraph) is reversed.

The decision of the Examiner to reject claims 2-8, 11, 12, and 14-21 under 35 U.S.C. § 102(b) is reversed.

The decision of the Examiner to reject claims 2-10, 12, 17, and 21 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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